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Dale Lowell Peterson

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER

MEINECKE DIAZ, SUSANNA M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/783,322	Applicant(s) PETERSON ET AL.	
	Examiner Susanna M. Diaz	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 10, 2008 has been entered.

Claims 7-10 have been cancelled.

Claim 1 has been amended.

Claims 1-6 and 11-12 are presented for examination.

Response to Arguments

2. Applicant's arguments with respect to claims 1-6 and 11-12 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-6 and 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'" (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Examples of insignificant post-

solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test.

It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495), <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf>.

Claims 1-6 and 11-12 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test; therefore, claims 1-6 and 11-12 are non-statutory under § 101.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-6 and 11-12 make reference to both a "loan consumer" and a "loan customer." It is not clear if these two phrases are meant to refer to the same person or different people.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nafousi (US 2004/0128262) in view of Official Notice.

Nafousi discloses a method of matching a loan consumer with lenders via the Internet (Fig. 1) comprising:

[Claim 1] a) receiving application information from the loan consumer (¶ 71);
b) storing the application information in a database (Fig. 1; ¶ 71);
c) applying a filter to the application information stored in the database to determine if the loan consumer meets a set of loan criteria (Figs. 1, 4; ¶¶ 71, 73, 78, 80, 85, 87, 92, 93, 98, 110);
d) submitting a subset of the application information to a credit bureau (¶¶ 70-71, 95);

e) receiving a credit report based on said submitting of the subset step (¶¶ 70-71, 95);

f) searching a lender database after said applying a filter step to match the loan customer application information and credit report to lenders in the database (Figs. 1, 4; ¶¶ 71, 73, 78, 80, 85, 87, 92, 93, 98, 110);

g) matching the loan customer application information to two or more of the lenders in the database based on said searching step (Figs. 1, 4; ¶¶ 71, 73, 78, 80, 85, 87, 92, 93, 98, 110);

h) transmitting a query to a lender of the two or more matched lenders matched from said matching step (Fig. 4 – If the lender system rejects the proposal, the proposal is sent to another matched lender; ¶¶ 81, 110);

i) receiving a response from the lender based on the query (Fig. 4, #114, 115, 119).

As per claim 1, Nafousi discloses that matched lenders may be iteratively queried with loan proposals (Fig. 4, #114, 115, 119, 150); however, the iteration ends when a lender accepts a proposal and the dealer accepts the proposal conditions or when all matched lenders have been queried with the proposal and no one accepts the proposal (Fig. 4; ¶¶ 157-158). Therefore, Nafousi does not explicitly disclose the step of j) repeating steps h and i, after said receiving of the response, so as to query *any remaining lenders* matched from said matching step. It is noted that Nafousi would anticipate step j in the scenario in which all matched lenders have been queried with the

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proposal and no one accepts the proposal or when the last of the matched lenders accepts the proposal and the dealer also accepts the proposal conditions. Official Notice is taken that it was old and well-known in the art at the time of Applicant's invention that the scenario of selecting or forming an agreement with the last option in a list of matched options is a common occurrence. While this scenario would randomly occur, limitation j reads on such a random occurrence (i.e., the last lender in a list of matched lenders happens to be the only lender in the group who accepts the proposal). In the event that such a scenario should occur, the Examiner submits that one of ordinary skill in the art at the time of Applicant's invention would have predicted the ability of Nafousi to accommodate j) repeating steps h and i, after said receiving of the response, so as to query any remaining lenders matched from said matching step. Furthermore, in this scenario, the modified Nafousi would effectively present the sole lender that accepted the proposal, as per step k) presenting to the loan customer only lenders who responded with an approval, the approval received during said receiving a response step since Nafousi displays information regarding the lender who accepted the proposal (¶¶ 156-159). Nafousi discloses l) storing a loan customer decision based on said presenting step (¶¶ 159-160). Additionally, it is noted that Nafousi's dealer acts on behalf of the loan customers; therefore, the dealer is interpreted as a functional equivalent of the claimed loan customer. The nature of the actual person sitting in front of the computer entering the customer's loan information (be it the customer him/herself or an agent thereof) does not affect the structural or manipulative steps of the invention;

therefore, such a distinction will not serve to patentably distinguish the claimed invention over the prior art.

Looking at steps j through l from a different perspective, Nafousi discloses that the dealer may accept a lender's conditions in response to a proposal, repropose conditions to the lender who responded, or reject the lender's proposed conditions and send the proposal to another matched lender (§ 159). The presenting step (step k) does not specify whether the results of steps i and j are aggregated and displayed at once or if they are displayed iteratively (e.g., as the lender responds). If displayed iteratively, Nafousi allows for such a display of approvals and a chance to review an approval from another lender (§§ 144-145). If displayed as an aggregated list of approvals, Nafousi is also capable of such a display of information, as seen in § 143, in which all lenders filtered as likely to accept a proposal may be displayed in a tabular form. While Nafousi's aggregated display is performed earlier in the initial filtering process, the Examiner takes Official Notice that it was old and well-known in the art at the time of Applicant's invention that aggregating various pieces of information on a single display provides a convenient means for a user to review, analyze, and compare displayed information. While Nafousi does not explicitly present the dealer with a list of multiple lenders who responded with an approval in response to the receiving a response step, Nafousi is clearly capable of displaying such aggregated information and Nafousi can iteratively display approval information from various lenders who respond with an approval. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Nafousi to

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perform the step of k) presenting to the loan customer only lenders who responded with an approval, the approval received during said receiving a response step (when multiple approvals are displayed at once) in order to facilitate that the dealer glean information about the lenders and which traditionally offer better loan conditions. The aggregated display of a history of approvals allows for more convenient access to the accumulated information at once, thereby making it easier to review, analyze, and compare the various lenders. Nafousi discloses l) storing a loan customer decision based on said presenting step (§§ 159-160). Additionally, it is noted that Nafousi's dealer acts on behalf of the loan customers; therefore, the dealer is interpreted as a functional equivalent of the claimed loan customer. The nature of the actual person sitting in front of the computer entering the customer's loan information (be it the customer him/herself or an agent thereof) does not affect the structural or manipulative steps of the invention; therefore, such a distinction will not serve to patentably distinguish the claimed invention over the prior art.

[Claims 11, 12] As per claims 11 and 12, Nafousi does not explicitly disclose that [Claim 11] step (k) includes sending only a predetermined number of lender responses, [Claim 12] wherein the predetermined number of lender responses is four or less than four responses. As seen in § 110 of Nafousi, Nafousi envisions a limit in the number of matched lenders that may be selected by a dealer in order to reduce traffic to the lenders. Official Notice is also taken that it was old and well-known in the art at the time of Applicant's invention to limit the number of items or services to be compared to one

another to a manageable number (e.g., a number of four or less). This helps to control the amount of information that a user has to process at once, thereby making the comparison process more manageable. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Nafousi such that [Claim 11] step (k) includes sending only a predetermined number of lender responses, [Claim 12] wherein the predetermined number of lender responses is four or less than four responses in order to more manageably present information to the dealer and customer for a quicker comparison of lenders while limiting the number of lenders involved in the process at one time in order to reduce traffic to the lenders, thereby making the overall lending process more efficient for the parties involved.

9. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nafousi (US 2004/0128262) in view of Official Notice, as applied to claim 1 above, in view of Lent (U.S. Patent No. 6,324,524), and further in view of Official Notice [now admitted prior art].

[Claims 2, 3] Nafousi does not explicitly disclose the steps of [Claim 2] validating the application information, [Claim 3] detecting an error and transmitting an error message to the loan consumer. However, Lent performs a validation of similar application data for purposes of extending credit (col. 4, lines 25-35; col. 6, lines 1-10; col. 7, lines 45-50), an approval process which is similar to that of approving a loan and Lent displays to an applicant the reason for rejection of an application (col. 12, lines 62-66). Official

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Notice is taken that it was old and well-known in the art of loan/credit processing that the applicant be made aware of the reason for rejection of an application for credit and/or a loan so that the applicant can attempt to correct any erroneously submitted data (e.g., a mistyped social security number) or be made aware of fraud being committed in his/her name (e.g., identity theft) [now admitted prior art]. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Nafousi to perform the steps of [Claim 2] validating the application information, [Claim 3] detecting an error and transmitting an error message to the loan consumer (as taught by Lent) in order to assist a rejected applicant in correcting any erroneously submitted data (e.g., a mistyped social security number) or in becoming aware of fraud being committed in his/her name (e.g., identity theft).

10. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nafousi (US 2004/0128262) in view of Official Notice, as applied to claim 1, in view of Lent (U.S. Patent No. 6,324,524).

[Claim 4] Nafousi does not expressly disclose that step (b) further comprises determining that the application information has been previously received less than a predetermined number of days prior and informing the loan customer to delay a new submission of application information until after the predetermined number of days is expired; however, Lent discloses that an applicant may be limited to reapplying for credit after a specified time period has elapsed (e.g., every 60 days) and informs the

applicant of this requirement if applicant attempts to reapply before the time period is up (col. 8, lines 41-55). Both Nafousi and Lent are directed toward processing requests for credit and/or a loan (which is based on one's credit score); therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Nafousi such that step (b) further comprises determining that the application information has been previously received less than a predetermined number of days prior and informing the loan customer to delay a new submission of application information until after the predetermined number of days is expired (as taught by Lent) in order to prevent a credit report from being needlessly accessed multiple times (as suggested in col. 8, lines 34-38 of Lent).

[Claims 5, 6] Nafousi does not expressly disclose that an active determination is made as to whether or not the application information has been previously stored more than a predetermined number of days (claims 5, 6) to either generate a loan consumer profile based on the application information (claim 5) or update a corresponding previously generated loan consumer profile (claim 6); however, Lent makes up for these deficiencies. Lent checks to see if entered applications are duplicate, previously interrupted, or new applications (they are presumed to be new if not a duplicate or previously interrupted) (col. 8, lines 31-61). Both Nafousi and Lent are directed toward processing requests for credit and/or a loan (which is based on one's credit score); therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Nafousi wherein step (b) further comprises determining that the application information has not been previously stored

and generating a loan consumer profile based on the application information (claim 5) and wherein step (b) further comprises determining that the application information has been previously stored more than a predetermined number of days prior and updating a corresponding previously generated loan consumer profile (claim 6) in order to prevent a credit report from being needlessly accessed multiple times (as suggested in col. 8, lines 34-38 of Lent) or to prevent the applicant from needlessly re-entering application data from scratch when the application process was previously interrupted (as suggested in col. 8, lines 59-61 of Lent).

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-6 and 11-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 and 11-13 of copending Application No. 11/648,514. Although the conflicting claims are not identical, they are not patentably distinct from each other because the main difference between the two claim sets is the specification that the filter and loan criteria are internally specified. Claim 11 of Application No. 11/648,514 further defines the internally specified loan criteria as being determined and set by “applying one or more of publicly available information, historical lender loan decisions, and market experience.” Sherman (US 2003/0229582) discloses the step of applying an internally specified filter to the application information to determine if the loan consumer meets a set of internally specified loan criteria (§§ 25, 26, 50-55, 57, 60), wherein the internally specified loan criteria is determined and set by applying one or more of publicly available information, historical lender loan decisions, and market experience (§ 57 – Evaluation of credit risk, e.g., based on an applicant’s credit report, is indicative at least of market experience); therefore, the Examiner submits that the use of internally specifically loan criteria, such as information associated with credit risk (e.g., market experience) would have been obvious to one of ordinary skill in the art to implement with a loan application processing system at the time of Applicant’s invention since it provides an accepted, standard benchmark by which various applications may be fairly assessed. Also, as seen in Sherman, filtering loan applications through predefined lending criteria reduces the “cost of processing needless applications by the lender” (§ 32) and requires that an “intermediary need only review one location for available programs of preselected

lenders and thereby, decreases the amount of time required to qualify the application in a program compatible with the applicant's financial criteria" (§ 33).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/
Primary Examiner, Art Unit 3692